

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Ullas Gargi
Serial No. : 10/631,369
Filed : July 31, 2003
Title : ORGANIZING A COLLECTION OF OBJECTS

Art Unit : 2168
Examiner : Oni, Olubusola
Confirmation No.: 2127

Commissioner for Patents
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RESPONSE TO ELECTION REQUIREMENT

In the Office action dated May 22, 2007, the Examiner has indicated that an election is required between the proposed "Species" of I, II, and III. In response to this election requirement, applicant provisionally elects "Species" I with traverse. Claims 1-21 and 22 read on the proposed "Species" I.

As explained in detail below, the election requirement is submitted to be improper because: (I) it would not be a serious burden for the Examiner to continue examining the application on the merits without the Election Requirement, (II) the Examiner is not authorized under the Rules to issue the Election Requirement, and (III) the Examiner has failed to establish a *prima facie* case for requiring an election of the claims.

I. IT WOULD NOT BE A SERIOUS BURDEN FOR THE EXAMINER TO
CONTINUE EXAMINING THE APPLICATION ON THE MERITS

MPEP § 803.01 provides that (emphasis added):

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

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The Examiner already has searched and examined the entire application on the merits before issuing the above-mentioned Election Requirement. The Examiner's Election Requirement therefore is improper at the present stage of prosecution because it would not be a serious burden for the Examiner to continue examining the application on the merits without the Election Requirement.

A summary of the prosecution history of the application is set forth below.

- 7/31/03 The application was filed with claims 1-51, where claims 1, 22, 23, 32, 33, 45, and 51 were independent claims, claims 2-21 depended from claim 1, claims 24-31 depended from claim 23, claims 34-44 depended from claim 33, and claims 46-50 depended from claim 45.
- 3/9/06 The Examiner mailed the first Office action on the merits, rejecting claims 1-51 under 35 U.S.C. § 102(e) over Platt (U.S. 2003/0009469).
- 5/31/06 Applicants mailed an Amendment in which: claims 1-22 were amended; claims 23-32 were left in their original form; claims 33-36 were amended; and claims 37-50 were left in their original form; and claim 51 was amended.
- 8/23/06 The Examiner mailed a final Office action in which she maintained the same rejection of claims 1-51 under 35 U.S.C. § 102(e) over Platt and issued a new ground of rejection of claims 1-32 and 51 under 35 U.S.C. § 101.
- 1/17/07 Applicants filed an Appeal Brief.
- 5/22/07 The Examiner re-opened prosecution by issuing the election requirement that is the subject of the instant Petition.

The Examiner already has fully and completely searched and examined the subject matter of all of the pending claims on the merits in the first and final Office actions dated 3/9/06 and 8/23/06. The scope of the subject matter recited in the pending claims is the same as the subject matter scope of the claims that already have been fully and completely examined on the merits. Therefore, it would not be a serious burden for the Examiner to continue examining the application on the merits, regardless of whether the application includes claims that are independent and distinct.

For at least this reason, Applicants request that the Examiner reconsider and withdraw the election requirement.

II. THE EXAMINER IS NOT AUTHORIZED TO ISSUE THE ELECTION REQUIREMENT

The Examiner is not authorized to issue the election requirement data May 22, 2007, because: (A) the Rules do not permit the Examiner to issue an election requirement where there is no generic claim; (B) the Rules do not permit the Examiner to issue an election requirement at the present stage of prosecution of the instant application; and (C) the Rules do not permit the Examiner to re-open prosecution of an application under appeal for the sole purpose of issuing an election requirement.

(A) The Rules Do Not Permit The Examiner To Issue An Election Requirement Where There Is No Generic Claim

The election requirement is traversed because the Examiner is not authorized to require the proposed election of "species". In particular, 37 CFR 1.146, which authorizes the Examiner to require an election of species, applies only to "an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby." The instant application, however, currently does not contain a generic claim that embraces all the identified "Species" I, II, and III. Without such a generic claim, the "Species" I, II, and III do not constitute species to which the claims properly can be restricted under 37 CFR 1.146 (see MPEP § 806.04).

For at least this additional reason, Applicants request that the Examiner reconsider and withdraw the election requirement.

(B) The Rules Do Not Permit The Examiner To Issue An Election Requirement At The Present Stage Of Prosecution

As explained above in § I, the Examiner already has fully and completely searched and examined the subject matter of all of the pending claims on the merits in the first and final Office actions dated 3/9/06 and 8/23/06. The scope of the subject matter recited in the pending claims is the same as the subject matter scope of the claims that already have been

fully and completely examined on the merits. Accordingly, under these circumstances the Rules do not permit the Examiner to issue the instant Election Requirement.

It is noted that 37 CFR § 1.142(a) only indicates that a requirement for restriction “may be made at any time before final action.” This provision, however, does not apply to the instant case because the Election Requirement in Examiner’s action dated May 22, 2007, was made after the final action dated August 23, 2006.

For at least this additional reason, Applicants request that the Examiner reconsider and withdraw the election requirement.

(C) The Rules Do Not Permit The Examiner To Re-Open Prosecution Of An Application Under Appeal For The Sole Purpose Of Issuing An Election Requirement

Under MPEP § 1207.04, “The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant’s brief or reply brief has been filed.”

In the instant case, the Examiner did not re-open prosecution to enter a new ground of rejection after the Appeal Brief was filed on January 17, 2007. Instead, the Examiner re-opened prosecution for the sole purpose of issuing the Election Requirement dated May 22, 2007. The Rules do not permit the Examiner to re-open prosecution of the instant application after the Appeal Brief was filed for the sole purpose of issuing an election requirement.

For at least this additional reason, Applicants request that the Examiner reconsider and withdraw the election requirement.

III. THE EXAMINER HAS FAILED TO ESTABLISH A *PRIMA FACIE* CASE FOR REQUIRING THE PROPOSED ELECTION OF CLAIMS

In the Office action dated May 22, 2007, the Examiner has required an election between Species I (method claims 1-21 and system claim 22), Species II (method claims 23-31 and system claim 32), and Species III (method claims 33-50 and system claim 51).

A. Species I and II

The Examiner has asserted that (emphasis added):

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention in group I has separate utility such as organizing a collection of object. The subcombination has separate utility such as segmentation engine and naming engine.

Contrary to the Examiner's assertion, "Species" I is not related to "Species" II as combination and subcombination. For example, claim 1 of "Species" I recites

Claim 1 (previously presented): A method of organizing a collection of objects arranged in a sequence ordered in accordance with a selected dimension of context-related metadata respectively associated with the objects, comprising:

classifying the objects in the sequence to generate a series of object clusters, wherein the classifying comprises sequentially processing each of the objects as a respective candidate for segmentation into a respective current one of the object clusters in the series and, for each of the candidate objects,

determining a candidate object interval separating the candidate object from an adjacent object in the sequence already segmented into the current object cluster, the candidate object interval being measured in the selected dimension of the context-related metadata,

comparing the candidate object interval to a weighted measure of cluster extent for the current object cluster, the measure of cluster extent corresponding to a current distance spanned by all the objects in the current object cluster measured in the selected dimension of the context-related metadata, and

comparing the candidate object interval to a weighted measure of object density for the current object cluster, the measure of object density corresponding to a measure of distribution of distances separating adjacent ones of the objects in the current object cluster measured in the selected dimension of the context-related metadata.

Claim 23 of "Species" II recites:

Claim 23 (original): A method of organizing a collection of objects, comprising:

- segmenting objects from the collection into clusters;
- extracting context-related meta data associated with the objects and parsable into multiple levels of a name hierarchy;
- and
- assigning names to clusters based on the extracted context-related meta data corresponding to a level of the name hierarchy selected to distinguish segmented clusters from one another.

Accordingly, "Species" I is not a combination of which "Species" II is a part (i.e., "Species" I and "Species" II are not related as combination and subcombination). Indeed, as acknowledged by the Examiner, "the combination as claimed does not require the particulars of the subcombination as claimed" (see page 4, lines 2-3, of the Office action). For example, claim 1 does not require any of the "extracting" and "assigning" elements of claim 23, and claim 23 does not require any of the "classifying", "determining", and "comparing" elements of claim 1.

For at least these reasons, the Examiner's asserted reasons for requiring an election between "Species" I and "Species" II do not support the Election Requirement and, therefore, the Election Requirement should be set aside.

B. Species I and III

The Examiner has asserted that (emphasis added):

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § a06.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention in group I has separate utility such as organizing a collection of object. The subcombination has separate utility such as a user interface engine to perform operations.

Contrary to the Examiner's assertion, "Species" I is not related to "Species" III as combination and subcombination. For example, claim 1 of "Species" I recites

Claim 1 (previously presented): A method of organizing a collection of objects arranged in a sequence ordered in accordance with a selected dimension of context-related metadata respectively associated with the objects, comprising:

classifying the objects in the sequence to generate a series of object clusters, wherein the classifying comprises sequentially processing each of the objects as a respective candidate for segmentation into a respective current one of the object clusters in the series and, for each of the candidate objects,

determining a candidate object interval separating the candidate object from an adjacent object in the sequence already segmented into the current object cluster, the candidate object interval being measured in the selected dimension of the context-related metadata,

comparing the candidate object interval to a weighted measure of cluster extent for the current object cluster, the measure of cluster extent corresponding to a current distance spanned by all the objects in the current object cluster measured in the selected dimension of the context-related metadata, and

comparing the candidate object interval to a weighted measure of object density for the current object cluster, the measure of object density corresponding to a measure of distribution of distances separating adjacent ones of the objects in the current object cluster measured in the selected dimension of the context-related metadata.

Claim 33 of "Species" III recites:

Claim 33 (previously presented): A method of organizing a collection of objects, comprising:

accessing a sequence of objects segmented into clusters each including multiple constituent objects arranged in a respective sequence in accordance with context-related meta data associated with the objects;

selecting for each object cluster at least two constituent objects representative of beginning and ending instances in the corresponding object sequence; and

in a user interface, graphically presenting the selected representative objects of each cluster without graphically presenting representations of unselected ones of the constituent objects of the clusters.

Accordingly, "Species" I is not a combination of which "Species" III is a part (i.e., "Species" I and "Species" III are not related as combination and subcombination). Indeed, as acknowledged by the Examiner, "the combination as claimed does not require the particulars of the subcombination as claimed" (see page 4, last two lines of the Office action). For example, claim 1 does not require any of the "accessing", "selecting", "presenting" elements of claim 33, and claim 33 does not require any of the "classifying", "determining" and "comparing" elements of claim 1.

For at least these reasons, the Examiner's asserted reasons for requiring an election between "Species" I and "Species" III do not support the Election Requirement and, therefore, the Election Requirement should be set aside.

C. Species II and III

The Examiner has asserted that (emphasis added):

Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention in group II has separate utility such as segmentation engine and naming engine. The subcombination has separate utility such as a user interface engine to perform operations.

Contrary to the Examiner's assertion, "Species" II is not related to "Species" III as combination and subcombination. For example, claim 23 of "Species" II recites

Claim 23 (original): A method of organizing a collection of objects, comprising:
segmenting objects from the collection into clusters;

extracting context-related meta data associated with the objects and parsable into multiple levels of a name hierarchy; and

assigning names to clusters based on the extracted context-related meta data corresponding to a level of the name hierarchy selected to distinguish segmented clusters from one another.

Claim 33 of "Species" III recites:

Claim 33 (previously presented): A method of organizing a collection of objects, comprising:

accessing a sequence of objects segmented into clusters each including multiple constituent objects arranged in a respective sequence in accordance with context-related meta data associated with the objects;

selecting for each object cluster at least two constituent objects representative of beginning and ending instances in the corresponding object sequence; and

in a user interface, graphically presenting the selected representative objects of each cluster without graphically presenting representations of unselected ones of the constituent objects of the clusters.

Accordingly, "Species" II is not a combination of which "Species" III is a part (i.e., "Species" II and "Species" III are not related as combination and subcombination). Indeed, as acknowledged by the Examiner, "the combination as claimed does not require the particulars of the subcombination as claimed" (see page 5, lines 16-17, of the Office action). For example, claim 23 does not require any of the "accessing", "selecting", "presenting" elements of claim 33, and claim 33 does not require any of the "segmenting", "extracting" and "assigning" elements of claim 23.

For at least these reasons, the Examiner's asserted reasons for requiring an election between "Species" II and "Species" III do not support the Election Requirement and, therefore, the Election Requirement should be set aside.

III. CONCLUSION

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Reply to Office action dated May 22, 2007

For at least the reasons explained above, Applicants request that the Examiner reconsider and withdraw the Election Requirement dated May 22, 2007.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

Respectfully submitted,

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